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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91175892
Party	Plaintiff Microsoft Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MICROSOFT CORPORATION,	)	
	)	
Opposer,	)	Opposition No. 91175892
	)	(Consolidated with Opposition No. 91175893)
v.	)	
	)	Serial Nos. 78/938513
MARK T. DANIEL,	)	78/930482
	)	
Applicant.	)	Attorney Docket Nos. 664005.898
<hr style="width: 35%; margin-left: 0;"/>	)	664005.899

**OPPOSER MICROSOFT'S OPPOSITION TO APPLICANT'S MOTION  
FOR PROTECTIVE ORDER AND TO STAY DISCOVERY;  
REQUEST FOR TELEPHONE HEARING UNDER TBMP § 502.06(A)**

## **I. Introduction and Summary**

Applicant Daniel's motion for a protective order and stay of discovery pending resolution of his August 15, 2007 motion to dismiss should be denied because:

1. Daniel failed to meet and confer with Opposer prior to filing the motion as required under Rule 26(c) of the Federal Rules of Civil Procedure.
2. His motion to dismiss, upon which he premises this motion, is fatally flawed and fails to provide the "good cause" required to stay discovery.
3. The discovery responses he seeks to postpone are long overdue and he failed to timely seek an extension.

The discovery that Daniel seeks to stay requires him to respond to pointed questions, *inter alia*, about his knowledge of Microsoft's ZUNE mark when he filed his intent-to-use applications for ZUNEGEAR and ZUNESLEEVE. Like Daniel's prior motions to dismiss and to suspend these proceedings, this motion is a stall tactic designed to delay Microsoft from obtaining this and other evidence fatal to Daniel's case.

For these reasons, and as explained more fully below, Microsoft asks that this motion be denied. Microsoft also requests a telephone hearing as provided under TBMP § 502.06(a) so that this matter can be resolved without further delay.

## **II. Argument**

### **A. Protective Orders Are Within the Board's Discretion for Good Cause Shown**

The Board has the discretion to grant a protective order for good cause shown and when justice requires, as provided for by Rule 26(c) of the Federal Rules of Civil Procedure, to protect a party from annoyance, embarrassment, oppression, or undue burden or expense. 37 CFR 2.120(f); TBMP § 526; *see Crown Wallcovering Corporation v. The Wall Paper Manufacturers Limited*, 188 USPQ 141, 144 (1975) (denying motion for protective order pending decision on motion to dismiss).

37 CFR 2.120(f) provides:

Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.

Daniel makes no claims of “annoyance, embarrassment, oppression, or undue burden or expense,” and as discussed below makes no showing of good cause.

**B. Daniel Failed to Meet and Confer Prior to Filing this Motion**

Rule 26(c) also requires that, prior to filing a motion for a protective order, the movant (Daniel) must have “in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action.” 37 CFR 2.117(a) (Federal Rules of Civil Procedure govern).

Moreover, the TBMP instructs that it is “inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order.” TBMP § 526. “Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper.” TBMP § 526.

Daniel’s motion for a protective order and discovery stay was improperly filed without a good faith attempt to confer with Microsoft’s counsel to try and resolve the dispute without involving the Board.

Daniel’s “effort” to confer with Microsoft’s counsel consisted of a single voice-mail on August 30, 2007, in response to Microsoft’s letter asking for his responses to discovery requests. Contrary to Daniel’s “Certificate of Compliance with Rule 26” filed with his motion for a protective order, Daniel did not (1) ask to meet and confer; (2) identify the subject matter of this motion or that he planned to file it; or (3) even ask Microsoft’s counsel to call him back. (Ferron Decl. ¶¶ 3-5). Instead, Daniel left an ambiguous voice-mail on August 30, 2007, saying he

would be mostly unavailable that day. He then filed the current motion the next day, August 31, 2007, without any further attempt to contact Microsoft. (Ferron Decl. ¶¶ 3-5).

A transcription of Daniel's entire voice-mail is reproduced below:

Good morning Bill. Mark Tyson Daniel calling from Virginia regarding the ZuneGear, ZuneSleeve matter before the TTAB. I did receive your letter. I was calling to discuss it. I will be mostly unavailable today although I'll be available after 3:30 Eastern time. It's now about 9:30 or so Eastern time on Thursday morning, August 30th. Thank you.

(Ferron Decl. ¶ 3).

As can be seen, Daniel's voice-mail makes no mention of his intention of filing for a protective order or even a request that Microsoft's counsel call him back. This is not a good faith attempt to confer with Microsoft to resolve the dispute without Board action. As such, Daniel's motion should be denied for this reason alone. *See, e.g., Varsity Gold, Inc. v. Bigham*, 2007 WL 185089, at \*1-2 (W.D. Wash. 2007) (without reaching issue of good faith, the court denied a motion for a protective order because the movant failed to mention a request for a protective when conferring with the non-movant).

**C. Daniel's Motion to Dismiss Provides No Good Cause for a Protective Order Staying Discovery—the Board Has Already Ruled That Microsoft's Pleadings Are Sufficient to State a Claim of Priority**

Daniel cannot reasonably base his motion for a protective order and discovery stay on his pending motion to dismiss. Daniel argues in his motion to dismiss that Microsoft did not properly plead analogous trademark use, one of the many independent basis for Microsoft's priority.<sup>1</sup> Daniel's arguments are directly contradictory to both the Board's June 14, 2007 Order, as well as the clear case law and USPTO practices.

As laid out in Microsoft's opposition to Daniel's motion to dismiss, Microsoft plainly alleges priority from, *inter alia*, analogous trademark use prior to Daniel's filing of his intent-to-use applications being opposed. (See Opposer Microsoft's Opposition to Rule 12 Motion, filed September 4, 2007, at pgs. 6-7). The Board agreed, in its June 14, 2007 Order, that Microsoft's

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<sup>1</sup> Microsoft's amended notices of opposition have several independent basis, each sufficient to oppose Daniel's intent-to-use applications. For example, Microsoft pleads (i) analogous trademark use prior to Daniel's filing of his intent-to-use applications, (ii) Daniel's intent-to-use applications are *void ab initio* because they are bad-faith filings with knowledge of Microsoft's adoption of the ZUNE mark, and (iii) Microsoft's ZUNE applications have priority under the Paris Convention.

amended notices of opposition were sufficient, holding that Microsoft's "allegations are sufficient to plead a priority claim derived from analogous use" and that "there is now a ground upon which relief may be granted [to Opposer] that is not dependent upon the status of [O]pposer's pleaded applications." Further, Microsoft's Application Serial No. 78/977970 for ZUNE has been approved and will soon register, establishing a clear priority date prior to Daniel. (See Opposer Microsoft's Opposition to Rule 12 Motion, filed September 4, 2007, at pg. 15). Given the specious nature of Daniel's motion to dismiss, there is no basis to suspend discovery or for a protective order, much less the good cause required by Rule 26(c).

**D. Daniel's Discovery Responses Are Long Overdue, So He Is Obligated to Answer Discovery**

Microsoft served its first set of discovery requests on Daniel on April 12, 2007. Pursuant to the Federal Rules of Civil Procedure and the Trademark Rules of Practice, Daniel's responses were due 35 days later.

Now, over five months later, Daniel has yet to serve responses to Microsoft's discovery requests. There is no suspension of proceedings, and Daniel has requested no extension of time to respond. Daniel therefore has no excuse for refusing to respond the outstanding discovery requests, and his current belated motion for a protective order and to suspend discovery does not excuse his tardiness.

Daniel's current motion relies on the faulty premise that the Board suspended the current opposition proceedings in response to Daniel's April 9, 2007 motion to suspend. To the contrary, the Board specifically held in its June 14, 2007 Order that "applicant's motion to suspend is denied."

But even giving Daniel the benefit of the doubt regarding a temporary suspension of his obligations to respond between his motion to suspend and the Board's June 14, 2007 Order denying his motion to suspend, Daniel's responses became due at least as of July 19, 2007, 35 days after the Board's June 14, 2007 Order.

Contrary to the instructions of TBMP § 526 to respond to discovery in a timely manner with objections, rather than filing a timely motion for a protective order, Daniel choose to ignore

Microsoft's discovery requests and the Board's June 14, 2007 Order denying his motion to suspend. Daniel's dilatory efforts in this current motion, when he made no efforts to request extensions of time to respond to discovery, are not a reasonable basis for a protective order and discovery stay. This is especially true given that Daniel's unfounded motion to dismiss is his entire basis for this motion seeking to further delay these proceedings.

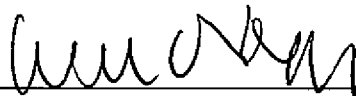
### **III. Conclusion**

Daniel's motion should be denied because he failed to comply with Rule 26(c) and confer with Microsoft prior to filing the motion. Also, the good cause required for a protective order suspending discovery under Rule 26(c) is not present given the specious nature of Daniel's motion to dismiss and because Daniel is already extremely tardy in serving his responses to Microsoft's first set of discovery requests. The Board should not retroactively relieve Daniel of the consequences of his failure to promptly respond to discovery requests.

For at least the reasons expressed above, Opposer requests that Applicant's motion for a protective order and stay of discovery be denied. As noted above, Microsoft asks that the Board grant a telephone conference so Daniel's current motion can be timely resolved.

DATED this 14<sup>th</sup> day of September, 2007.

SEED IP Law Group PLLC



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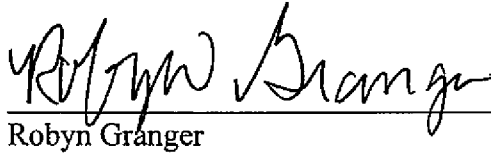
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Attorneys for Opposer  
MICROSOFT CORPORATION

**CERTIFICATE OF SERVICE**

I hereby certify that on this 14<sup>th</sup> day of September, 2007, the foregoing OPPOSER MICROSOFT'S OPPOSITION TO APPLICANT'S MOTION FOR PROTECTIVE ORDER AND TO STAY DISCOVERY AND REQUEST FOR TELEPHONE HEARING UNDER TBMP § 502.06(A) was served upon Applicant by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

Mark T. Daniel  
2316 York Road SW  
Roanoke, VA 24015-3906

  
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Robyn Granger